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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/682,876

Filing Date: October 26, 2001

Appellant(s): DUCHOW, MARK

Michael J. McGovern
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 7, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed*

The appellant's statement of the grounds of rejection to be reviewed (Grounds of Rejection) in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Prior Art of Record*

6,259,405	STEWART et al	7-2001
6,185,541	SCROGGIE et al	2-2001

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

(a) The amendment filed August 25, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the Applicant has attempted to narrow the original definition of "product" from including "both goods and services" to "goods and not services unless specified". This amendment, if entered, would change the scope of the invention from what was originally disclosed at the time of filing (See *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000)).

Applicant is required to cancel the new matter in the reply to this Office Action.

(b) Claims 76-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (6,259,405) in view of Scroggie et al (6,185,541).

Claim 76: Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer visiting a website on the Internet, comprising:

- a. providing screen displays to allow the customer to select a desired producer (airline)(col 24, lines 29-33);
- b. providing screen displays to allow the customer to enter product selection information (reservation information), personal ID data, and a postal code (col 20, lines 48-54 and 61-67);
- c. receiving the above data through the Internet (col 9, lines 35);

- d. generating a voucher (offer) redeemable only at a reseller selected by the system (col 27, lines 26-37);
- e. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32); and
- f. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).

Stewart discloses the user (MU) entering the desired producer (such as an airline or hotel chain), product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller (local hotel) which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart

discloses a plurality of methods for determining the user's location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a promotional program aimed at a large area (city) instead of a specific location (shopping mall).

Claim 77: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. As discussed above, Stewart discloses that the system selects the local retailer (specific hotel) automatically

once the customer has selected the producer and desired product (and location information). Thus, the customer's control over selection of the reseller is limited to entering such information (producer, product, and location).

Claim 78: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses transmitting a message to the customer after a car reservation is completed indicating the preparedness of the car and then adds that the price of the product may also be transmitted to the customer (col 21, lines 12-19). Thus, it is disclosed in the first instance that the message may be transmitted to the customer without the price also being transmitted (and displayed).

Claim 79: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart also discloses the customer entering the data and receiving the information during a single online session (col 22, lines 49-50). While Stewart also discloses that the system may use previously stored information about the customer's demographic and preference information, in some of the disclosed embodiments the customer enters this information during the session.

Claim 80: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further

discloses that the customer receives a single voucher (advertisement/discount/coupon) during the session (since only one product is being selected). Furthermore, it is a design decision by the system operator and/or the advertiser on determining how many vouchers to send to the customer during the session. The Examiner further notes that while a marketer could allow multiple coupons to be redeemed for a single item, it is usual and customary in the marketing arts to only allow one voucher (coupon/discount) to be applied to a purchase of a product. Therefore, it would have been obvious to only distribute one voucher for the one product selected by the customer in Stewart. One would have been motivated to only distribute a single voucher in order to prevent a customer from redeeming so many vouchers that the product is free; thus, defeating the purpose of the voucher. For example, if the system issues a \$1.00 discount voucher for a \$5.00 product and the customer redeems 5 of the voucher on a purchase of a single unit of the product, the customer would effectively pay nothing for the product (except possible sales taxes). If the customer redeemed 6 voucher for the same product, the reseller would not only have to give the product to the customer for free, but would also owe the customer an additional dollar.

Claim 81: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the system selecting a restaurant, rental car agency, or airline serving the user's location based on the stored preferences of the user and the user's location (col 20, line 47 – col 24, line 42). Additionally, Scroggie further discloses that the buyer may go to the manufacturer's offer page and select one or more product offers from a

manufacturer (col 7, line 64- col 8, line 21). The system will then select and display one or more local retailers which sell that product. It is inherent that if the product is an exclusive product, i.e. one which is sold by only one retail chain, such as a franchise (e.g. Skilcraft Tools™ sold by Sears), that the system would display the local or closest Sears store. Likewise, if the user selected Kentucky Fried Chicken (KFC) as the manufacturer and fried chicken as the product, the system would select the KFC franchisee which had been assigned coverage of the geographic location of the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Stewart would select the reseller which had been assigned coverage of the geographic location of the user.

Claim 82: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the system selecting the local retailer based on the customer's entry of a desired hotel chain or car rental company (i.e. producers) and the customer's location. While in some embodiments, Stewart also bases the selection on the customer's stored demographic information, this is not the case in all embodiments.

Claim 83: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the voucher is a purchase price discount of the selected product (e.g. "Next 3

customers to purchase a Nintendo 64 entertainment system pay only \$29.99.")(col 26, lines42-67).

Claim 84: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the personal information includes the email address of the customer (col 11, lines 21-31).

Claim 85: : Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer visiting a website on the Internet, comprising:

- a. providing screen displays to allow the customer to select a desired producer (airline)(col 24, lines 29-33) and product selection information (reservation information)(col 20, lines 48-54 and 61-67);
- b. providing screen displays to allow the customer to enter personal ID data, and a postal code (col 20, lines 48-54 and 61-67);
- c. receiving the above data through the Internet (col 9, lines 35);
- d. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).
- e. generating a time limited voucher (offer)(e.g. "For the next 15 minutes, all watches are 25% off at ABC Watch Company, which is located in the A concourse,

between gates 14 and 16")(col 28, lines 36-40) redeemable only at a reseller selected by the system (col 27, lines 26-37); and

f. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32).

Stewart discloses the user (MU) entering the desired producer (such as an airline or hotel chain), product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller (local hotel) which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart discloses a plurality of methods for determining the user's location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an

entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a promotional program aimed at a large area (city) instead of a specific location (shopping mall).

Claim 86: This claim includes the same features and limitations as Claim 77 above and is rejected as being obvious as discussed above.

Claim 87: This claim includes the same features and limitations as Claim 78 above and is rejected as being obvious as discussed above.

Claim 88: This claim includes the same features and limitations as Claim 79 above and is rejected as being obvious as discussed above.

Claim 89: This claim includes the same features and limitations as Claim 80 above and is rejected as being obvious as discussed above.

Claim 90: This claim includes the same features and limitations as Claim 81 above and is rejected as being obvious as discussed above.

Claim 91: This claim includes the same features and limitations as Claim 82 above and is rejected as being obvious as discussed above.

Claim 92: This claim includes the same features and limitations as Claim 83 above and is rejected as being obvious as discussed above.

Claim 93: This claim includes the same features and limitations as Claim 84 above and is rejected as being obvious as discussed above.

(10) Response to Argument

(a) The claimed subject matter is not obvious over Stewart et al. U.S. Pat. No. 6,259,405 in view of Scroggie et al U.S. Pat. No. 6,185,541.

(1) Obviousness Considerations Under 35 U.S.C. 103 and *Graham v. John Deere*.

The Appellant recites the basis for obviousness.

(2) Claims 76, 83 and 84, 85, 92 and 93 are not obvious in view of Stewart and Scroggie.

The Appellant presents several arguments against the references (pages 10-24).

First, the Appellant argues that the steps are not being performed in the same sequence in the references as in the claims. Second, the Appellant argues that the customer in Stewart does not enter his location, nor a customer identity, but that the information had already been pre-entered and was just being retrieved by the system. Third, the Appellant argues that Stewart's targeted advertising is not the same as the claimed purchase incentive. Fourth, the Appellant argues that Scroggie does the operational sequence in reverse from the claimed invention and cannot be combined with Stewart.

In response to the arguments that the steps are not being performed in the same sequence in the references as in the claims and that the customer does not enter his location and customer identity, the Examiner notes that the Appellant's invention receives three types of information from the customer prior to selecting the reseller and presenting the voucher to the customer. These are the customer's selection of a producer; the customer's selection of a product (from the producer); and the customer's personal contact information and postal address code (by which the system identifies the customer's location). The Examiner sees no patentable distinction in the order in which this information is received by the system, as long as all three types of

information have been received by the system prior to selecting the reseller and providing the voucher to the customer. Furthermore, even if patentable weight must be given to the order in which the customer enters the requested information, Official Notice could be taken that it is old and well known to receive the producer and product selections from the customer before requesting the customer's personal contact information and postal address code. In most on-line shopping websites, the prospective customer browses through the website catalog, selects one or more products to purchase, and then selects the "purchase" button or icon. Only then does the website request the customer complete the shipping and billing information (i.e. personal contact information and postal address code). Support for this Official Notice can be found in the following references: Hill (5,528,490); Green et al (5,664,110); Doyle et al (5,694,551); Chelliah et al (5,710,887)(previously provided as item A on the PTO-892 of paper number 9); and Westrope et al (5,721,832) to name a few. The Stewart reference which forms the main part of the rejection of these claims explicitly discloses the customer selecting a producer (manufacturer) and a product and submitting this information along with the customer's personal contact information and location *prior* to the system selecting a reseller or providing the voucher (coupon) to the customer. While Stewart has numerous embodiments in which the customer's identification code and location information are automatically provided to the system and the system automatically provides offers for services and advertisements based on this identification/location information, it is explicitly disclosed that in some embodiments the customer (MU) may register with the system without providing demographic

information (col 13, lines 33-36); that "the MU may enter requested data in order to gain access to the service provider" (col 14, lines 63-65); and that "the MU manually selects whether they desire a service and transmit an appropriate response to the AP" (col 13, lines 22-25). The Examiner notes that Stewart further discloses that the AP offers services (and goods) from a wide variety of service providers such as "rental car agencies, hotels, restaurants, airline reservation centers, banks, taxi services, bus and train reservation offices, printing services, on-line database services, message services, E-mail providers, advertising providers and other content providers"; and that "this list is not meant to limit the quantity or type of goods, information and/or service providers, but instead it is noted that the scope of possible goods, information and service providers is generally limitless" (col 13, lines 54-63). In one embodiment, the "MU may instruct the service provider of a planned future geographic location at which the MU would prefer to pick up the print job" but may instead "desire that the print job be sent to his final destination" (col 20, lines 6-28). Thus, it is clearly disclosed that the customer enters not only the desired provider and product, but also his identification and location. Once the system has received this information it then selects the closest reseller (merchant/service provider) to the customer (or the location the customer so designated as the receiving point as in the printing example).

As to the Appellant's argument that the Stewart targeted advertising is not the same as the claimed incentives, the Examiner notes that Stewart explicitly discloses that "the targeted advertising may be based at least partly on the known geographic location of the MU ... and also possibly based on the demographic information of the

user" (col 27, lines 62-67). Immediately above that, Stewart had given some examples of the targeted advertising such as "a digital coupon that allows them to buy BIG MACs for \$0.99 for the next six months"; 25% off all watches at ABC Watch Company, which is located in the A concourse; or "The next 50 customers who request a submarine sandwich at DEF Restaurant will receive a free drink". While these examples don't explicitly state that the MU had requested information about purchasing a watch or ordering food, since Stewart is "targeting" the advertising it would have been obvious to do so. If the customer had requested information about making reservations on a certain airline to certain flight that afternoon, it would have been inappropriate according to Stewart to present an advertisement/voucher for a local hotel since the information indicates that the customer is planning on leaving town. Furthermore, in the above cited embodiments where the customer is not required to enter demographic information to utilize the system, but still selects the desired service or good, the only "targeting" information available to the system would be the customer's location and selected good/service. In a final note, such a selection process in which the voucher is for the product selected by the customer is explicitly shown in Scroggie. That system consists of "transmitting a list of products available for purchase, receiving customer selections from the list of products" (col 2, lines 10-13) "and possibly transmitting at least one purchase incentive pertaining to an ingredient product used in a selected recipe" (col 2, lines 25-28 and col 6, lines 12-28). Thus, it would have been at least obvious for Stewart to present advertising (coupons/discount vouchers) targeted to the product or products selected by the customer.

This leads into the Appellant's fourth argument that Scroggie cannot be combined with Stewart because Scroggie performs the steps in reverse from the claimed invention. First, the Examiner notes that Scroggie was used only to show that it would have been obvious to include a postal zip code in the address submitted by the customer in Stewart. Second, since both references pertain to presenting information to a customer, receiving customer selection of one or more goods/services to purchase, and presenting targeting advertising/coupons/discount vouchers to the customer, they are analogous art and would have been obvious resources for someone looking to set up such a coupon/purchasing system. The criteria for obviousness is not whether the whole of the two references can be bodily inserted into each other, but whether one of ordinary skill in the art looking at the two references would have been motivated to combine one part of one reference with another part of the other reference. In this case, the Examiner could have used any reference which disclosed that a customer's address includes a postal zip code. And third, Scroggie discloses that the customer has only selected the service provider (e.g. Giant Supermarkets) prior to selecting the products. Once the product selections have been entered, the system displays a list of (Giant) supermarkets in the customer's immediate shopping area from which the customer selects one. All coupons (vouchers) "will be specific to this selected supermarket and invalid everywhere else" (col 9, line 66 – col 10, line 3). Thus, *in contra* to the Appellant's argument even Scroggie discloses the customer selecting the service provider and products *prior* to the selection of the specific reseller (supermarket).

(3) Claims 77 and 86 are not obvious in view of Stewart and Scroggie.

The Appellant quotes a Stewart citation (col 22, lines 49-53) as showing that the customer selects the specific hotel and not the system. However, as the Appellant noted, this disclosure is in the alternative. Stewart explicitly discloses that the MU (user) may or may not designate a specific hotel, and that if none is designated “the service provider may be operable to select the hotel...”. The Appellant’s argument that the first part of this alternative “takes the example outside the language of the claim 77 and claim 86” (page 29) does not address the second alternative. The only limitation entered in Claim 77 and 86 is that the customer enters the selection of the product (or service) and his zip code (location), not the selection of the reseller. This is exactly what the second alternative in the Stewart citations does...the system selects the reseller (specific hotel) based on the customer’s request for a hotel room (product) and his location information (geographic proximity).

(4) Claims 78 and 87 are not obvious in view of Stewart and Scroggie.

The Appellant argues that Stewart does not disclose that the reseller is selected in a sequence in which the purchase price is not displayed to the customer (pages 29-31). The Appellant emphasizes that the advantage of his invention is “in commercial fields where the prices are not well known”, “which is not the case for car rentals and hotels (published rates) and grocery stores and fast food outlets with small prices per product, the approximate prices being known to the customer” (page 30). The

Examiner notes that in the Appellant's invention the customer selects a desired producer and selects a desired product *prior* to seeing any advertising or vouchers. This implies that the customer knows at least the producer and has some idea of the type of desired product, if not the exact product, beforehand. It would be speculative, at best, to assert that the customer utilizing the Appellant's invention would not have knowledge of at least "the approximate prices" for that product beforehand also. In any case, the claim reads on any system in which the purchase price of the product is not shown to the user during the same sequence in which the system selects the reseller. As the Appellant has stated, the final purchase price for such things as a car rental is sometimes prevented from being displayed to the customer by such things as taxes and insurance. Thus, the final purchase price may not be displayed in Stewart's car rental example. Furthermore, Stewart discloses an incentive voucher (advertising/coupon) being displayed which identifies the specific reseller (ABC Watch Company) without identifying the purchase price of the watch, only that it is 25% off. Thus, Stewart's disclosure that the car rental message may or may not include the price of the product reads on the claims' limitation.

(5) Claims 79 and 88 are not obvious in view of Stewart and Scroggie.

The Appellant argues that neither reference discloses that the selection of the product, the entry of the personal contact information, and the communication of the voucher occurs in only one access to the website (pages 31-32). However, the Examiner notes that Stewart discloses that "In another embodiment, the database 325A

or MIB 150 does not store demographic information received from a user, but rather this information is stored only on the user's PCD and thus is entirely within the user's control" (col 11, lines 4-7). Thus, when the user accesses the system to request a hotel reservation, a car rental, etc. the entire procedure (select product and provider, submit request, receive response with selected reseller and voucher) takes place during one access – there is no pre-stored information. Stewart also discloses that when the user is not already registered with the system, the system can offer to provide services anyway, with the user then entering in the product and provider selection, etc. Therefore, contrary to the Appellant's assertion, Stewart discloses at least two embodiments in which the entire sequence is completed within one access to the website.

(6) Claims 80 and 89 are not obvious in view of Stewart and Scroggie.

The Appellant argues that neither reference disclosed that only one voucher is offered per one access to the website (page 32). The Examiner notes, first, that it is entirely up to the voucher provider (advertiser) on how many vouchers to offer per visit, just as it is also the voucher provider's choice on how many times a voucher can be used, what time frame the voucher remains active, etc. These are all normal choices made by any advertiser or voucher/coupon provider. As stated in the rejection, it is a well known practice for coupon issuer to only allow one coupon to be redeemed per product being purchased and to issue coupons "one-to-a-customer". Stewart also explicitly disclose that the "targeted advertising may be time-sensitive, or quantity

Art Unit: 3622

sensitive, or unrestricted" (col 27, lines 26-56 and col 28, lines 31-44) and gives some examples such as a coupon for a \$0.99 BIG MAC or a free drink with the purchase of a submarine sandwich. In none of these examples does Stewart suggest that the user receives multiple coupons/vouchers/advertising during the session, although it would definitely be possible if the voucher provider so desired. Thus, the Appellant is arguing that because Stewart does not explicitly state that only one voucher is being presented during one access it does not apply to the claim limitation.

(7) Claims 81 and 90 are not obvious in view of Stewart and Scroggie.

The Appellant argues that it would not have been obvious to direct the customer in Stewart to the reseller who has been assigned exclusive marketing rights for the area in which the customer is located (pages 33-35). As has been stated throughout the prosecution, franchises with pre-assigned exclusive marketing areas are well known. One example of this is a Kentucky Fried Chicken (KFC) franchise. While each individual KFC outlet is owned and operated by an individual owner, the chain (KFC) maintains strict control on how close other franchises can be to one another...i.e. they have pre-assigned exclusive marketing areas. Contrary to the Appellant's arguments, local franchise owners often have their "owner special" discount offers in which other franchise owners nearby may or may not participate. Thus, since the system in Stewart selects the reseller based at least in part on the geographic location of the customer, it would have been obvious to select the reseller who had been assigned a marketing area which encompasses that geographic location.

(8) Claims 82 and 91 are not obvious in view of Stewart and Scroggie.

The Appellant argues that Stewart must have pre-stored demographic information and that there is no "embodiment which illustrates the user entering all of the needed information in one online session". This is the same argument presented against Stewart in reference to Claims 76 et al and Claims 79 and 88 above. As shown above, Stewart discloses at least two embodiments in which the customer enters all of the information in one session when there is no pre-stored demographic information. Furthermore, the Examiner notes that Claims 82 and 91 do not include the argued limitation that all the information is entered in one session, only that the selection of the reseller does not use pre-stored demographic data or direct customer selection through a screen display, which has been answered in the first response above.

(b) The amended definition of products for purposes of submitting these claims is not new matter. This ground of rejection is argued as applied to all Claim 76-93.

The Appellant argues that changing the definition of "product" by amending paragraph 0002 of the specification from "both goods and services" to "goods and not services unless specified" does not change the scope of the invention. The Appellant argues that he is only being his own lexicographer to make the claims easier to read (pages 36-37). However, as the Appellant indicates during the argument, this change is actually being made in an attempt to overcome the prior art which the Appellant believes is directed towards services and not goods. However, Stewart discloses the

advertising (voucher) is in at least one instance directed towards the sale of watches, which the Examiner doesn't believe are made by the ABS Watch Store in the airport. In any case, the Examiner believes that the amendment to the specification is an attempt to further narrow the scope of the specification in order to overcome the prior art in violation to 35 U.S.C. 132(a) and believes the Board should rule in favor of upholding this rejection under 35 U.S.C. 132.

(c) The amendment to paragraph 0045 is not new matter and is made to make the specification consistent and to encompass examples that are apparent to one of ordinary skill in the art to which the invention pertains. This ground of rejection is argued as applied to all claims 76-93.

(The Examiner notes that this rejection was made in the May 25, 2004 response to the April 5, 2004 amendment)

The Appellant argues that changing paragraph 0045 of the specification from "The structured computer program 130 selects the reseller or resellers that sell the product in memory 140 selected by the buyer 100 and that are located closest to the buyer 100 based on the zip code in memory 140 entered by the buyer." to "The structured computer program 130 selects the reseller that sells the product in memory 140 selected by the buyer 100 and that has the territory that includes, or is closest to, the buyer 100 based on the zip code in memory 140 entered by the buyer." is merely changing the phrase to state what was inherently meant by it in the first place (pages 37-44). However, the Examiner believes changing the reseller from one closest to the buyer to one which has the (assigned) territory covering or is closest to the location of

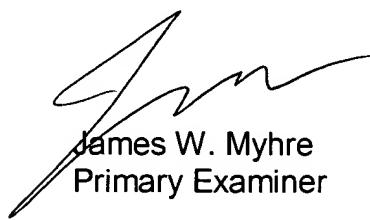
the buyer completely changing the scope of the invention. To cite an example the Examiner has presented to the Appellant during the prosecution, two resellers are located in St Louis, Missouri (Reseller 1) and Kansas City, Kansas (Reseller 2). Each reseller has been assigned by the product producer exclusive rights to sell the product within their respective states (Missouri and Kansas, respectively). A customer who lives in Kansas City, Missouri, wants to buy the product and accesses the Appellant's website. Under the original specification, the customer would be directed to the closest reseller (Reseller 2). Under the amended specification, the customer would be directed to the reseller who has the assigned area covering the customer's location (Reseller 1). Thus, this amendment would not only change the scope of the invention, but would also give a completely different result in the above scenario. In view of this, the Examiner recommends the Board rule in favor of the rejection of this amendment under 35 U.S.C. 132.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JWM
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